

PATENT APPLICATIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)
RHODES et al.) RENEWED PETITION UNDER
Int'l. Serial No.: PCT/AU99/00917) 37 C.F.R. 1.47(a)
Int'l. Filing Date: 22 October 1999)
Priority Date: 18 November 1998) "EXPRESS MAIL" MAILING LABEL NO: EV068074576US
U.S. Serial No. 09/831,579) DATE OF DEPOSIT: 12/10/02
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) SIGNATURE: *Janice Messer*

Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231
Attn: PCT Legal Office

Dear Sir:

Applicants respectfully renew their petition for filing when an inventor refuses to sign, under 37 C.F.R. § 1.47(a), in compliance with MPEP § 409.03(c), when a co-inventor has died. The following document is being submitted:

A second Declaration for Utility or Design Patent Application, listing the citizenship, residency and mailing address for each of Mr. Miller, Mr. Winby and Ms. Winby (executrix for the estate of Mr. Winby);

REMARKS

Applicants original Petition under 37 CFR 1.47(a) and request under 37 CFR 1.42 filed 21 December 2001, was dismissed for the reason stated in the Decision on Petition mailed 17 May 2002, a copy of which is enclosed herewith. The PCT Legal Examiner has indicated that a new declaration stating the citizenship, residency and mailing address for each of Mr. Miller, Mr. Winby and Mrs. Winby (executrix for the estate of Mr. Winby) is required. Applicants submit herewith a new declaration listing the citizenship, residency and mailing address for each of Mr.

Miller, Mr. Winby and Mrs. Winby and signed by Mr. Miller. Applicants submit that this new declaration complies with the requirements of 37 C.F.R. 1.497(a)-(b).

The PCT Legal Examiner also states that Mrs. Winby's reluctance to sign the declaration documents and the absence of her express oral or written refusal to accept and sign the papers does not constitute a refusal as set forth in MPEP 409.03(d). Applicants agree. However, Applicants have not based their conclusion regarding Mrs. Winby's conduct on her stated reluctance to sign the necessary documents. Indeed, Applicant's conclusion that Mrs. Winby's conduct constitutes a refusal to sign the documents is based on the facts listed in the declaration of Richard H. Baddeley at page 2, numbered 9 (a)-(d).

As stated in section 409.03(d) of the MPEP;

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Applicants have concluded that Mrs. Winby's conduct constitutes a refusal to sign the necessary documents. It was not the original expressions of reluctance to sign the documents noted by the PCT Legal Office, but these repeated expressions followed by her failure to sign and return the documents when presented with the application papers and sufficient time to examine the documents and respond by returning the signed documents. Applicants have included the full details of Mrs. Winby's repeated contacts and her stated "reluctance" to sign the documents in compliance with the above-quoted section of the MPEP, namely in an attempt to state "all facts upon which that conclusion is based . . .".

Furthermore, Applicants do not suggest that Mrs. Winby refused to accept the documents as stated by the PCT Legal Office. Indeed, in further compliance with the MPEP section quoted above, Applicants have submitted documentary evidence, in the form of a copy of the entire mailing sent to Mrs. Winby and postal records verifying its delivery and receipt, showing that Mrs. Winby did receive the documents. Mrs. Winby then had ample opportunity to review the

application and return the signed documents to Mr. Baddeley, patent counsel in Australia. It is this last opportunity given to Mrs. Winby, in which the formal application papers and declarations were sent to Mrs. Winby coupled with the fact that she did not sign and return the documents, upon which Applicants have concluded that Mrs. Winby's conduct constitutes a refusal to sign the declaration documents.

Finally, in compliance with the last sentence of the MPEP section quoted above, Applicants have included what they believe to be the reason for Mrs. Winby's refusal to sign the necessary application papers; namely that Mrs. Winby attributes her husband's death to the demands imposed by the requirements of his position at BacTech, and she therefore desires to have no involvement with BacTech in further prosecution of patent rights. This is stated in the declaration of Richard H. Baddeley at page 2, number 9 (d).

In view of the above discussion, Applicants respectfully submit that it is not Mrs. Winby's stated "reluctance" to sign the necessary application papers, but her continually stated reluctance followed by her failure to sign and return the documents when formally presented with them that constitutes conduct sufficient to base a conclusion that she refuses to "make application" as stated in MPEP 409.03(c). Applicants therefore respectfully request reconsideration of the petition on the merits based on these facts and the submission of a new declaration complying with the requirements of 37 C.F.R. 1.497(a)-(b).

Respectfully submitted,

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